Remarks

This paper is filed in response to the Official Action mailed by the USPTO on July 18, 2007 which provided a three months statutory period of time for reply with no additional fee. Since this response is filed within the allotted three months statutory period set for response, it is believed that no fee is required. However, should the office deem any fees necessary in insuring that this response is proper, the Office is authorized to deduct any necessary fees from applicants' USPTO Deposit Account No. 13-4125 and to credit any overpayment thereto.

The Examiner has indicated that the preliminary amendment filed in this case on February 3, 2005 were non-compliant with respect to 37 CFR 1.121. Therefore, the amendments to the specification and claims submitted in improper form are reintroduced herein above and are believed to be compliant with 37 CFR 1.121. With this response, the specification has been amended to recite the cross reference to related applications. No new matter has been added. Also, claims 1-20 and 32-42 are cancelled without prejudice, and new claim 43 is added. Also, claims 21, 23-26, and 28-30 are amended. The new claim and the amendments are believed to be fully supported by the specification as filed, and no new matter is added. Amendments to the claims 21, 23-26 and 28 were suggested by the Examiner and are believed to comply with the objections to these claims raised by the Examiner in the above referenced Official Action. The amendment to claim 29 merely corrects the spelling of MON863, removing the space between the letters and the numbers of that word. The amendment to claim 30 is believed to be supported by the specification as filed, and in particular at page 4, lines 17-19. Basis for the new claim 43 is believed to be supported by the specification as filed, and in particular at page 24, lines 10-14 and throughout the specification and claims as filed. It is respectfully requested that the Examiner enter the amendments to the specification and claims.

Claim Objections

The Examiner set forth a number of objections to the form and content of several of the claims.

The informalities are believed to be addressed with the amendments as suggested by the Examiner, adding or deleting commas as suggested and correcting misspellings and so forth. (See

Examiner's Remarks under Paragraph No. 3, page 2 of the Official Action). It is believed that the amendments to the claims has fully addressed these particular objections.

The Examiner has also objected to the form or content of claims 24 and 28 under 37 CFR 1.75(c), in the sense that, in the opinion of the Examiner, corn oil, corn starch and corn syrup do not contain DNA. While it is stipulated that highly purified corn oil and corn syrup do not generally contain detectable amounts of corn DNA, it is not stipulated that highly purified corn starch would not contain detectable amounts of corn DNA, and for that matter, corn oil and corn syrup that are not highly purified do in fact contain detectable amounts of corn DNA and therefore the claims in fact intentionally read on these compositions that contain detectable amounts of corn DNA. It is believed the skilled artisan would recognize this limitation. For example, claim 23 is an independent claim from which claim 24 depends and is limited in scope to compositions that comprise the indicated nucleotide sequences. If the recited nucleotide sequence is present in the extract and can be detected as provided in the specification, the composition is within the scope of the claim. The same argument applied for claim 28 as to the claims from which it depends (claims 25-27). Therefore, it is believed that claims 24 and 28 are of proper form and properly further limit the subject matter of the previous claims from which they depend. The amendments to claims 24 and 28 are believed to result in these claims being of proper dependent form. Also, the amendment to claim 28 which introduces the limitation regarding a detectable amount of said nucleotide sequence is supported throughout the specification as filed, and in particular at page 24, lines 1-9.

The Examiner also objected to Claim 30 as being of improper dependent form for failing to further limit the subject matter of a previous claim. It is believed that the amendment to claim 30 addresses the Examiners' concern.

It is respectfully requested that the Examiner remove these grounds of objection.

Claim Rejections 35 USC 112, First Paragraph

The Examiner has rejected claims 21-31 under 35 USC 112 first paragraph for lack of enablement reasons, stating that the claims contain subject matter that was not described in the specification in such a was as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In particular the Examiner is asserting that the specification is deficient in the sense that it does not have the proper statement

required under 37 CFR 1.809(d) in cases in which a biological deposit may be required for enablement. The Applicant traverses this rejection.

37 CFR1.809(d) requires that for a deposit made pursuant to 37 CFR 1.801-1.809, (1) the specification shall contain the accession number for the deposit,(2) the date of the deposit, (3) a description of the deposited biological material sufficient to specifically identify it and to permit examination, and (4) the name and address of the depository.

In this case, the application as filed contains at page 24, lines 10-14, the requisite description: (1) the accession No.PTA-2605, (2) the date of the deposit of October 17, 2000, (3) a description of the deposited biological material sufficient to specifically identify it and to permit its examination: corn seed comprising the MON863 event further described as corn Zea mays event MON863 PV-ZMIR13, and (4) the name and address of the depository set forth as American Type Culture Collection (ATCC), 10801 University Boulevard, Manassas, Virginia, USA ZIP 20110-2209. Therefore, it is believed that the specification is fully compliant with the requirements set forth in the regulations as to this matter.

The Applicant is providing herewith a Declaration of Biological Deposit along with a copy of the deposit receipt for the above referenced deposit.

It is believed that the evidence provided obviates the Examiners' rejection under 112, first paragraph, and it is respectfully requested that this grounds of rejection be removed.

Claim Rejections 35 USC 112, Second Paragraph

The Examiner has rejected claims 23 and 28 under 35 USC 112 second paragraph for indefiniteness. It is believed that the amendments to these claims obviate the basis for the indefiniteness rejection, and so it is respectfully requested that this grounds of rejection be removed.

Claim Rejections – 35 USC 102

The Examiner has rejected claims 24 and 28 under 35 USC 102(b) as being anticipated by Vattikonda (2000, US Patent No. 6,137,038) as having disclosed corn starch, corn oil, and corn syrup. The Applicant traverses this rejection of these claims.

The Applicant has amended claim 28 to recite a composition comprising a detectable amount of the nucleotide sequences that are diagnostic for the MON863 event. Claim 24 already

has this limitation included in it because claim 24 is dependent from a claim that has a limitation that requires that an extract comprise the recited nucleotide sequences. Vattikonda fails to teach or disclose the recited nucleotide sequences and/or the MON863 event. Vattikonda therefore is an improper reference under 102(b). It is respectfully requested that the Examiner remove this grounds of rejection.

The Examiner has also indicated that claims 21-22 and 29-31 are rejected under 35 USC 102(e) as being anticipated by Pershing et al (2003, US Patent NO. 6,551,962), suggesting that the disclosure of the MON863 event in Pershing et al, which has an effective filing date prior to the filing date of the instant application, constitutes prior art under 35 USC 102(e) to the instant invention as claimed. The Applicant traverses this rejection for the reasons as follows.

As stated above, the ATCC seed deposit was effectuated on October 17, 2000. The construction of transgenic seeds embodies years of effort from the initial cloning and construction of a nucleotide sequence for use in plant transformation, through the plant cell transformation process, regeneration of viable plants from transformed plant cells, molecular characterization of transgenic plant events generated during the transformation process, and evaluation of the transgenic events that pass a first step in molecular characterization to be fully evaluated for their efficacy as a commercial embodiment. Seeds deposited with an appropriate depository such as with ATCC in this case, are typically in-bred, so that the transgene is present on both copies of the relevant chromosome into which the transgene has been inserted, and so the seed are typically homozygous for the transgene insertion. All of these steps require, as specified above, years to complete, and so as of the date the seed is deposited, at least two to three years of effort have been undertaken by the inventors to get to this stage. Therefore, in this case, since Pershing et al has an effective filing date of October 6, 2000, and the seed deposit was effective as of October 17, 2000, it should be clear that the disclosure of MON863 in Pershing et al was based on information obtained from the present inventors in this case, in particular given the time frame involved in developing the subject claimed technology. If the Examiner finds this reasoning unacceptable to obviate this rejection under 102(e), the Applicant will provide the appropriate 37 CFR 1.131 or 1.132 showing to the satisfaction of the Office.

Additionally, Pershing et al is not enabled for the MON863 event. Even though the seed deposit for the MON863 event was made during the pendency of the Pershing et al prosecution, Pershing et al makes no disclosure regarding the requirements set forth in 37 CFR 1.801-1.809 as

specified by the Examiner above as being required for enablement in the instant application. The Pershing et al specification and file history do not provide the accession number for the deposit, the date of the deposit, a description of the deposited biological material sufficient to specifically identify it and to permit examination, and does not name and address of the depository. Therefore, Pershing et al is not an enabling reference for the MON863 event.

Therefore, based on the reasoning provided above, it is respectfully requested that the Examiner remove this grounds of rejection.

Claim Rejections – 35 USC 103(a)

The Examiner has rejected claims 31-41 in this case as being obvious under 35 USC 103(a) in view of Pershing et al. The applicant traverses this rejection.

103(a) is specifically limited to references that are "prior art" to the subject matter claimed. Pershing et al was not published prior to the effective filing date of the instant application, and so fails as a proper reference for use in this type of rejection by the Examiner. Therefore it is believed that the Applicant has obviated this 103(a) rejection and it is respectfully requested that this rejection be removed.

Should any questions arise or if Applicant or Applicant's attorney can facilitate the examination of this application, it is respectfully requested that the PTO contact the undersigned attorney.

Respectfully submitted,

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